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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/015,094 | 12/11/2001 | Sanjay Mehta | IN-5527 | 6657 |

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BASF CORPORATION
ANNE GERRY SABOURIN
26701 TELEGRAPH ROAD
SOUTHFIELD, MI 48034-2442

| EXAMINER | |
|---|---|
| CHEUNG, WILLIAM K | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1713 | |

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/015,094 | MEHTA ET AL. | |
| | Examiner | Art Unit | |
| | William K. Cheung | 1713 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *08 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,14 and 16-22* is/are rejected.

7)☒ Claim(s) *7-13,15 and 23-31* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. Applicant's affirmed election of Group I invention, claims 1-31, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Therefore, in view of lack of traversal to restriction requirement set forth from Response to Restriction Requirement, the restriction set forth by the examiner is deemed proper and is therefore made Final.

2. In view of amendment filed March 8, 2005, claim 32 has been cancelled.

3. In view of Terminal Disclaimer filed March 8, 2005, the rejection of Claims 1-31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,657,007 is withdrawn.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-6, 14, 16-22 stand rejected under 35 U.S.C. 103(a) as obvious over Menovcik et al. (US 5,976,615).

*The invention of claims 1-6, 14, 16-22 relates to a* ***clearcoat coating composition*** *comprising*

*(a) a least one member selected from the group consisting of*

*(1) an* ***acrylic polymer*** *having both* ***secondary hydroxyl functionality*** *and functionality selected from the group consisting of* ***carbamate functionality***, ***urea functionality***, *and* ***both*** *carbamate and urea functionality and*

*(2) a mixture of a* ***first acrylic polymer*** *with* ***secondary hydroxyl functionality*** *and a* ***second acrylic polymer*** *with functionality selected from the group consisting of* ***carbamate functionality, urea functionality***, *and* ***both*** *carbamate and urea functionality;*

*(b)* ***a carbamate-functional or urea-functional material*** *that is the reaction product of*

*(1) a compound comprising a* ***primary carbamate*** *or* ***primary urea group*** *and* ***an hydroxyl*** *group and*

*(2) **a compound** that is **reactive with hydroxyl groups** on a **plurality of molecules** of compound (1), but that is not reactive with the carbamate or urea groups on compound (1)and*

*(c) a **crosslinking component** comprising a **crosslinker reactive** with **active hydrogen** groups.*

Menovcik et al. in its entirety, (particularly in the abstract; col. 9, line 12 to col. 10, line 60; col. 12, claim 1) disclose a curable acrylic coating composition comprising carbamate functional material and a crosslinking agent, reactive with the carbamate group. Since the compositions of Menovcik et al. comprise functionalities that are substantially identical to the composition being claimed in claims 1-6, 14, 16-22, the examiner has a reasonable basis to believe that the claimed composition and the compositions of Menovcik et al. are substantially identical.

The difference between the composition of Menovcik et al. and claims 1-6, 14, 16-22 is that Menovik et al. are silent on a composition comprising a secondary hydroxyl functionality.

However, Menovcik et al. (col. 9, line 9-21) clearly teach a compound comprising hydroxyl functionality which generically includes secondary hydroxyl functionality as claimed. Motivated by the expectation of success of preparing a clear coat, it would have been obvious to one of ordinary skill in art to use hydroxyl functionality teachings

in Menovcik et al. to use primary, secondary, or tertiary hydroxyl groups to obtain the invention of claims 1-6, 14, 16-22.

Applicant's arguments filed March 8, 2005 have been fully considered but they are not persuasive. Applicants argue that the instant specification has included comparative data to demonstrate the criticality of the claimed "secondary hydroxyl" feature of the invention. However, upon a careful evaluation of the comparative data, the examiner finds that the comparative data do not commensurate to the scope of the invention. To obtain a valid patent, applicants should run the experiments, side by side, with one experiment having a secondary hydroxyl and the other experiment having a primary hydroxyl. This is critical because the prior art of Menovcik et al. has already disclosed an inventive clear coating comprising a hydroxyl functionality that generically includes primary, secondary, and tertiary hydroxyl functionalities.

Further, the examiner recognizes that there are process-related limitations in the claims to define how the components are being made for the claimed compositions. However, applicants must recognize that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product

was made by a different process." In re Thorpe, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

***Allowable Subject Matter***

6. Claims 7-13,15 and 23-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and that the ODP rejection set forth in instant office action is overcome.

***Conclusion***

7. **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William K. Cheung

Primary Examiner

April 1, 2005

WILLIAM K CHEUNG
PRIMARY EXAMINER